REMARKS

Claims 1, 4, 7-8, 10-23, 28, 41-42, 44-45, 49, and 50-51 have been amended. Claims 53-74 have been added. Claims 6, 24-27, 29-40, 43, 48, and 52 have been cancelled. Therefore, claims 1-5, 7-23, 28, 41-42, 44-47, 49-51, and 53-74 are pending in the application.

Objection

Claim 38 was objected to. Claim 38 has been cancelled. Accordingly, this rejection is moot.

Section 102(b) Rejection

The Office Action rejected claims 1-3, 7-10, 13-15, 22, 23 and 52 under 35 U.S.C. § 102(b) as being anticipated by Theimer et al. (U.S. Patent 5,627,517) (hereinafter "Theimer"). As set forth in more detail below, Applicant respectfully traverses the rejection as to the currently pending claims.

With respect to claim 1, the cited art fails to anticipate, teach, or suggest a central server receiving via a network a request to ship an item from an origination to a final destination; the central server searching a database for a most inexpensive routing; the central server generating a data file comprising at least the following: intermediate destination information identifying one or more intermediate destinations and final destination information identifying a final destination; the central server transferring the data file over a network; and storing the data file in a memory device that accompanies the item. Theimer fails to teach or suggest a central server searching a database for a most inexpensive routing and generating a data file. Furthermore, none of the other cited art, either alone or in combination with Theimer, teaches or suggests such a feature. Accordingly, claim 1 is patentable over the cited art.

Section 103(a) Rejection

The Office Action rejected claims 4-6, 11-12, 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Theimer. Applicant respectfully traverses these rejections.

Applicant asserts that claim 4 is patentable over the cited art for at least the foregoing reasons given above with respect to claim 1. Further with respect to claim 4, the cited art fails to teach or suggest forwarding copies of at least a portion of the data file via a network to one or more of the parties involved in the shipping. The Office Action asserts that "because the system of Theimer is a distribution system, there must exist a network among parties. Therefore, it would have been obvious to one of ordinary skill in the art to forward copies of the data file." However, "the general principle behind [Theimer] is that each package is ultimately responsible for its own fate in the distribution system, as opposed to a centralized system in which each package being tracked is a passive object under the control of a central control system." Theimer, col. 3, lines 47-51. In Theimer, "each package has associated therewith its own 'intelligent' tag which retains the desired destination of the package." Theimer, col. 5, lines 8-10. The intelligent tags interact with each node (e.g., by transmitting a response identifying an ultimate or intermediate destination node (col. 4, lines 1-6) or by sending instructions saying "this is my stop" (col. 4, lines 59-63)). The nodes do not need dynamic information about other nodes. For example, a system controlling an input node only needs to know which conveyors would carry the package to other nodes in non-linear systems; in linear systems, no additional information about other nodes is needed (col. 5, lines 42-54). Since only a small and static amount of information about other nodes may be needed, this information could easily be programmed into each node's controller and manually updated as needed. Thus, no network is needed to communicate information between the nodes in order to implement Theimer's distribution system. In fact, a network would appear to be unduly expensive and complicated for the system of Theimer. Applicant notes that, "[i]n relying on a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the

applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Given that a network is not needed to implement Theimer's distribution system, a network is not an inherent part of Theimer. Furthermore, given that no network is suggested by Theimer, there is no suggestion to forward copies of a data file via a network. Accordingly, claim 4 is patentable over the cited art. Claim 5 is patentable for similar reasons.

With respect to claim 11, the cited art fails to teach or suggest storing the data file on a server connected to a network, where the server provides access to the data file via the network. As noted above, there is no suggestion of any networked communication of the data file in Theimer, nor is there any suggestion to store additional copies of the data file on a server. Accordingly, claim 11 is patentable over the cited art.

With respect to claim 12, the cited art fails to teach or suggest storing a data file that includes item weight information in a memory device that accompanies an item. In its rejection of this claim, the Office Action merely asserts that "it would have been obvious to one of ordinary skill in the art to include weight information in the data file of Theimer since having information on item weight helps shippers maintain capability of loading and packing items efficiently." Applicants note that mere speculation or unfounded assumption is not sufficient to support a *prima facie* case of obviousness. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious <u>in light of the teachings of the references</u>... [S]implicity and hindsight are not the proper criteria for resolving the issue of obviousness." *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int'f 1985) (emphasis added). Since no teachings of any references have been cited in support of this rejection, Applicants assert that the Office Action has failed to support a *prima facie* case of obviousness and accordingly traverse this rejection.

With respect to claim 16, the cited art fails to teach or suggest that the data file further includes one or more digital images of the item before, during, or after shipping. Since no references have been cited in support of either teaching or suggesting the inclusion of digital images in the data file, Applicants assert that the Office Action has failed to support a *prima facie* case of obviousness and accordingly traverse this rejection. Claim 17 is patentable for similar reasons.

Claims 18, 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer, in view of Welles (U.S. Patent 5,686,888). Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of Wortham (U.S. Patent 5,999,091). Claims 18-21 depend from claim 1. Accordingly, these claims are patentable over the cited art for at least the reasons given above with respect to claim 1.

Claims 24-36 and 41-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer, in view of Shavit et al (U.S. Patent 4,799,156) (hereinafter "Shavit"). Applicant asserts that pending claims 28, 41-42, 44-47 and 49, which depend from claim 1, are patentable for at least the reasons given above with respect to claim 1.

With respect to claim 50, the cited art fails to teach or suggest a computer program configured to: receive a shipping request via a network for an item to be shipped, select a shipping route for the item based on shipping information included in a database, where the shipping route comprises one or more intermediate destinations and uses two or more different shipping companies; confirm the selected shipping route via a network; generate a data file comprising: a unique item identifier, origination information, intermediate destination information, and final destination information; transfer the data file via the network, and store the data file in a memory device that accompanies the item. In particular, neither Shavit and Theimer, alone or in combination, teach or suggest a computer program configured transfer a data file comprising: a unique item identifier, origination information, intermediate destination

information, and final destination information via a network. Furthermore, there is no proper suggestion to combine Shavit and Theimer. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Thus, Theimer teaches away from using a centralized system such as that taught in Shavit, stating that "the general principle behind [Theimer] is that each package is ultimately responsible for its own fate in the distribution system, as opposed to a centralized system in which each package being tracked is a passive object under the control of a central control system." Theimer, col. 3, lines 47-51. Accordingly, claim 50 is patentable over the cited art for at least the foregoing reasons.

Claim 51 is patentable over the cited art for at least the foregoing reasons given with respect to claim 50.

Claims 37 and 39 were under 35 U.S.C. § 103(a) as being unpatentable over Theimer, in view of Shavit and further in view Welles. Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer, in view of Shavit, and further in view of Wortham. These claims have been cancelled, and thus these rejections are moot.

Added Claims

Claims 53-74 have been added. Claims 73-74 depends from claim 1 and are thus patentable for at least the reasons given above with respect to claim 1.

With respect to claim 53, the cited art fails to anticipate, teach, or suggest a system that includes a database of shipping information; a central server coupled to the database and configured to select a shipping route for an item in response to querying the database, where the central server is configured to generate a data file including information identifying an origination, destination, and intermediate destination

comprised in the shipping route; and a memory device configured to be coupled to the item and configured to receive and store a copy of the data file generated by the central server. Claims 54-70 are patentable for at least these reasons.

With respect to claims 71 and 72, the cited art fails to anticipate, teach, or suggest a method that involves receiving a request to ship an item from an origination to a final destination; searching a database for a most inexpensive routing, where the most inexpensive routing includes using two or more different shipping companies and one or more intermediate destinations; generating a data file comprising intermediate destination information identifying the one or more intermediate destinations, one or more digital images of the item, and final destination information identifying the final destination; and storing the data file in a memory device that accompanies the item.

Comments Regarding Previously Submitted Information Disclosure Statements

Applicants note that only one Form PTO-1449 (received by the PTO on Aug. 22, 2002) was returned with the Office Action of November 7, 2002. No initialed and signed copies of the Forms PTO-1449 mailed June 11, 2002 and June 26, 2001 were returned. A copy of these previously submitted Forms PTO-1449 are submitted herewith for the Examiner to properly initial, sign and return. Applicants request the Examiner to carefully consider the listed references and return copies of the signed and initialed Forms PTO-1449.

CONCLUSION

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition

1. (Amended) A method for shipping goods, wherein the method comprises:

a central server receiving via a network a request to ship an item from an origination to a
final destination;

the central server searching a database for a most inexpensive routing, wherein the most
inexpensive routing includes using two or more different shipping companies and
one or more intermediate destinations;

the central server generating a data file comprising at least the following:

intermediate destination information identifying the one or more intermediate
destinations, and

final destination information identifying the final destination;

the central server transferring the data file over a network; and

storing the data file in a memory device that accompanies the item.

4. (Amended) The method as recited in claim [2] 1, further comprising forwarding copies of at least a portion of the data file via [a] the network to one or more [of the] parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and two or more shipping companies.

7. (Amended) The method as recited in claim [2] 1, further comprising shipping the item using the least expensive routing.

8. (Amended) The method as recited in claim [2] 1, further comprising:

packing the item in a container;

inserting the container in a first carrier with a first set of additional containers bound for a
first of the one or more intermediate destinations; and

shipping the first carrier to the first intermediate destination.

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10. (Amended) The method as recited in claim [2] 1, wherein the data file further comprises contact information for one or more shipping companies that will handle the item.

11. (Amended) The method as recited in claim [2] 1, further comprising storing the data file on a server connected to [a] the network, wherein the server provides access to the data file via the network.

12. (Amended) The method as recited in claim [2] 1, wherein the data file further comprises item weight information.

13. (Amended) The method as recited in claim [2] 1, wherein the data file further comprises item handling information.

14. (Amended) The method as recited in claim [2] 1, wherein the data file further comprises item content information.

15. (Amended) The method as recited in claim [2] 1, wherein the data file further comprises payment information.

16. (Amended) The method as recited in claim [2] 1, wherein the data file further includes one or more digital images of the item before, during, or after shipping.

17. (Amended) The method as recited in claim [2] 1, wherein the data file further includes one or more digital images of the item showing the physical condition of the item upon receipt at one or more intermediate destinations.

18. (Amended) The method as recited in claim [2] 1, wherein the memory device further comprises a temperature sensor, wherein the temperature sensor is configured to periodically measure and store temperature readings in the data file.

19. (Amended) The method as recited in claim [2] 1, wherein the memory device further comprises a humidity sensor, wherein the physical humidity sensor is configured to periodically measure and store humidity readings in the data file.

20. (Amended) The method as recited in claim [2] 1, wherein the memory device further comprises an environmental sensor, wherein the environmental sensor is configured to periodically measure and store in the data file information about one or more environmental factors that the item experiences during shipment.

21. (Amended) The method as recited in claim [2] 1, wherein the memory device further comprises a vibration sensor, wherein the vibration sensor is configured to record any vibrations greater than a preprogrammed threshold in the data file.

22. (Amended) The method as recited in claim [2] 1, wherein the memory device is coupled to a wire-less communications device.

23. (Amended) The method as recited in claim [2] 1, further comprising:
detecting one or more obstacles to on-time delivery of the item, searching the database
        for a new least expensive routing that avoids the obstacles; and
updating the data file to reflect the new least expensive routing.

28. (Amended) The method as recited in claim [27] 1, further comprising updating the data file on the central server to reflect [the item's] arrival of the item at one or more of the intermediate destinations.

41. (Amended) The method as recited in claim [24] 1, wherein the memory device is a flash memory device.

42. (Amended) The method as recited in claim [24] 1, wherein the memory device is a CD-RW.

44. (Amended) The method as recited in claim [24] 1, wherein the [responses] database include price information and delivery time information.

45. (Amended) The method as recited in claim [24] 1, further comprising:
detecting one or more obstacles to on-time delivery of the item, soliciting new quotations
for shipping the item from one of the intermediate locations to the final
destination by transmitting a supplemental request for quotation via the network;
receiving additional responses to the supplemental request for quotation via the network;
selecting an alternate shipping route for the item based on the additional responses; and
confirming the selected alternate shipping route via the network.

49. (Amended) The method as recited in claim [24] 1, further comprising
updating the data file on the central server to reflect the item's arrival at the final
destination.

50. (Amended) A computer program embodied on a computer-readable medium,
wherein the computer program is configured to:
receive a shipping request via a network for an item to be shipped from an origination to
a final destination;
search a database of shipping information;
select[ing] a shipping route for the item [based on the responses] based on the shipping
information included in the database, wherein the shipping route comprises one or
more intermediate destinations and uses two or more different shipping
companies;
confirm the selected shipping route via [a] the network;
generate a data file comprising at least the following:
a unique item identifier,
origination information,
intermediate destination information, and
final destination information;
transfer the data file via the network; and

store the data file in a memory device that accompanies the item, wherein the memory
device is configured to allow the data file to be updated at one or more of the
intermediate destinations.

51. (Amended) The computer program of claim 50, <u>wherein the computer
program is</u> further [comprising] <u>configured to</u> maintain[ing] and updat[ing]<u>e</u> the database
by sending requests for quotes using the network.